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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,233	10/25/2000	Vikas Sanathana Murthy	EFIM0317	2894

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EXAMINER

PHILLIPS, HASSAN A

ART UNIT PAPER NUMBER

2151

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,233

Applicant(s)

MURTHY ET AL.

Examiner

Hassan Phillips

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to remarks and amendments filed on April 7, 2005.

Drawings

2. After consideration of the amendments made to the drawings and specification, Examiner has withdrawn the objections to the drawings.

Response to Arguments

3. Applicant's arguments filed July 19, 2004 have been fully considered but they are not persuasive. Applicant argued that Examiner used impermissible hindsight in combining the teachings of Peacock with the AAPA, and that one of skill in the art would not use the method taught by Peacock with the AAPA since mobile phones did not have dynamically assigned IP addresses, like the personal computers taught by Peacock.

4. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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As indicated by the Applicant, it was well known by one of ordinary skill at the time the claimed invention was made that **several** different types of communication devices existed besides mobile phones that could receive text messages. Among these devices included personal computers, (see Applicants disclosure page 1, lines 14-17). As also indicated by the Applicant, it was well known by one of ordinary skill that these devices operated on different networks having different carriers, (see Applicants disclosure page 1, lines 17-20). Since personal computers operated on different networks having different carriers, and since personal computers were capable of receiving dynamically assigned IP addresses, Applicants arguments that one of ordinary skill would not combine the teachings of Peacock with AAPA are moot. Examiner therefore maintains that the combination of the teachings of Peacock with the AAPA is proper.

5. Furthermore, the Examiner has interpreted the claim language as broadly as possible. It is also the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in a manner that distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterated the need for Applicant to define the claimed invention more clearly and distinctly.

Accordingly the references supplied by the examiner in the previous office action covers the claimed limitations. The rejections are thus sustained. Applicant is requested to review the prior art of record for further consideration.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, 5, 10, 13, 15, 18, 19, 24, 27, 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock, U.S. Patent No. 6,381,650, in view of the Applicants Admitted Prior Art (AAPA).

8. In considering claims 1, 15, and 24, Peacock teaches a method, apparatus, and computer-readable medium for determining a valid destination address, comprising: sending an availability request to each destination address from a plurality of destination addresses, the plurality of destination addresses being correlated with a destination party; receiving at least one response to the sent availability requests, each received response being uniquely associated with its own destination address from the plurality of destination addresses, each received response indicating one from the group of a valid destination address and an invalid destination address; and recording, for each

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received response, a value associated with the destination address associated with that received response, the value indicating one from the group of a valid destination address and an invalid destination address based on the received response associated with that destination address. See col. 2, lines 9-29.

Although the disclosed method, apparatus, and computer-readable medium taught by Peacock shows substantial features of the claimed invention, they fail to expressly disclose: the destination address having a carrier identifier.

Nevertheless, the AAPA teaches it was well known in the art at the time of the present invention for networks of different types to have carrier identifiers (page 1, line 14, through page 2, line 11).

Thus, given the teachings of AAPA, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Peacock with the AAPA in order to have carrier identifiers in each destination address from the plurality of destination addresses. This would have enhanced the teachings of Peacock by providing a means for determining valid destination addresses (Peacock col. 3, lines 51-53) in a variety of networks (AAPA page 1 line 14, through page 2 line 5), and communicating across the various networks utilizing the valid destination address (Peacock col. 6, lines 11-18).

9. In considering claim 10, Peacock teaches a method for determining a valid international destination address, comprising: reading a record associated with a destination party, the record having a plurality of destination addresses correlated with the destination party, each destination address having at least a network identifier and a

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device identifier, (col. 3, lines 59-67); sending an availability request to each destination address from the plurality of destination addresses of the record; receiving at least one response to the sent availability requests; and updating the record associated with the destination party based on each received response to the sent availability requests, (col. 2, lines 9-29).

Although the disclosed method, taught by Peacock shows substantial features of the claimed invention, it fails to expressly disclose: the destination address having a carrier identifier.

Nevertheless, the AAPA teaches it was well known in the art at the time of the present invention for networks of different types to have carrier identifiers (page 1, line14, through page 2, line 11).

Thus, given the teachings of AAPA, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Peacock with the AAPA in order to have carrier identifiers in each destination address from the plurality of destination addresses. This would have enhanced the teachings of Peacock by providing a means for determining valid destination addresses (Peacock col. 3, lines 51-53) in a variety of networks (AAPA page 1 line 14, through page 2 line 5), and communicating across the various networks utilizing the valid destination address (Peacock col. 6, lines 11-18).

10. In considering claims 4, 5, 13, 18, 19, 27, and 28, Peacock further teaches: each destination address from the plurality of destination addresses having at least a network identifier, and a device identifier, (col. 3, lines 59-67).

Although the disclosed method, apparatus, and computer-readable medium taught by Peacock shows substantial features of the claimed invention, they fail to expressly disclose: the destination address having a carrier identifier, or gateway identifier.

Nevertheless, the AAPA teaches it was well known in the art at the time of the present invention for networks of different types to be interconnected by means of gateways (page 2, lines 1 and 2), and for carrier operators in mobile phone networks to require a carrier identifier for a destination mobile phone (page 2, lines 8-11).

Thus, given the teachings of AAPA, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Peacock with the AAPA in order to include gateway identifiers and carrier identifiers in each destination address from the plurality of destination addresses. This would have enhanced the teachings of Peacock by providing a means for determining valid destination addresses (Peacock col. 3, lines 51-53) in a variety of networks, such as mobile phone networks (AAPA page 1 line 21 through page 2 line 5), and communicating across the various networks utilizing the valid destination address (Peacock col. 6, lines 11-18).

11. Claims 2, 3, 11, 12, 16, 17, 25, 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock and AAPA, in view of Sawyer et al. (hereinafter Sawyer), U.S. Patent No. 5,946,629 (see Applicants IDS).

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12. In considering claims 2, 3, 11, 12, 16, 17, 25, and 26, although the disclosed method, apparatus, and computer-readable medium taught by Peacock shows substantial features of the claimed invention, they fail to expressly disclose: sending text messages.

Nevertheless, sending text messages in a network was well known in the art at the time of the present invention. Sawyer teaches a method and apparatus for facilitating inter-network message communications within a telecommunications network comprising: sending text messages between the telecommunication network and other connected networks. See col. 2, lines 6-52.

Thus, given the teachings of Sawyer, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Peacock with Sawyer in order to have text messages sent to each destination address from the plurality of destination addresses. This would have enhanced the teachings of Peacock by providing a means for determining valid destination addresses (Peacock col. 3, lines 51-53) in a variety of networks (Sawyer col. 1, lines 29-43), and communicating across the various networks utilizing the valid destination address (Peacock col. 6, lines 11-18).

13. Claims 6-8, 14, 20-22, 29-31, are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock and AAPA in view of Gibbs, U.S. Patent No. 6,356,935.

14. In considering claims 6-8, 14, 20-22, and 29-31, although the disclosed method, apparatus, and computer-readable medium taught by Peacock shows

substantial features of the claimed invention, they fail to expressly disclose: self-authentication by the destination party.

Nevertheless, self-authentication was well known in the art at the time of the present invention. Gibbs teaches an improved method of self-authentication comprising: adding supplemental information to an electronic message, the supplemental information being associated with self authentication by the destination party; and sending the electronic message and the added supplemental information to at least one destination address. See col. 5, lines 23-32.

Thus, given the teachings of Gibbs, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Peacock with Gibbs in order to add supplemental information to an electronic message, the supplemental information being associated with self-authentication by the destination party; and send the electronic message and the added supplemental information to at least one destination address having an associated received response indicating a valid destination address. This would have enhanced the teachings of Peacock by providing an efficient means for reducing unauthorized communication, Gibbs col. 2, lines 56-60.

15. Claims 9, 23, and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock and AAPA in view of Gibbs.

16. In considering claims 9, 23, and 32, Peacock further teaches: each destination address from the plurality of destination addresses having a network identifier, (col. 3, lines 59-67).

Although the teachings of Peacock show substantial features of the claimed invention, they fail to expressly disclose: the destination address having a carrier identifier.

Nevertheless, the AAPA teaches it was well known in the art at the time of the present invention for carrier operators in mobile phone networks to require a carrier identifier for a destination mobile phone (page 2, lines 8-11).

Thus, given the teachings of AAPA, it would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Peacock with the AAPA in order to include carrier identifiers in each destination address from the plurality of destination addresses. This would have enhanced the teachings of Peacock by providing a means for determining valid destination addresses (Peacock col. 3, lines 51-53) in a variety of networks, such as mobile phone networks (AAPA page 1 line 21 through page 2 line 5), and communicating across the various networks utilizing the valid destination address (Peacock col. 6, lines 11-18).

Although the disclosed method, apparatus, and computer-readable medium taught by Peacock shows substantial features of the claimed invention, it fails to expressly disclose: self-authentication by the destination party.

Nevertheless, self-authentication was well known in the art at the time of the present invention. Gibbs teaches an improved method of self-authentication

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comprising: generating a plurality of codes each being uniquely associated with each destination address from a plurality of destination addresses, each code being uniquely associated with a time of being generated; receiving a self-authentication message from a destination address from the plurality of destination addresses, the self authentication message having a code value. See col. 4, line 7 through col. 6, line 6.

Thus, given the teachings of Gibbs, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Peacock and AAPA with Gibbs in order to validate a destination address from the plurality of destination addresses based on the code value of the self-authentication message corresponding to a code from the plurality of codes. This would have enhanced the teachings of Peacock by providing an efficient means for reducing unauthorized communication, Gibbs col. 2, lines 56-60.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ZARNI MAUNG
SUPERVISORY PATENT EXAMINER